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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,013	09/11/2003	Dustin C. Kirkland	AUS920030632US1	5894

35525 7590 04/21/2008	EXAMINER
IBM CORP (YA)	LY, ANH
C/O YEE & ASSOCIATES PC	

	ART UNIT	PAPER NUMBER
P.O. BOX 802333	2162	
DALLAS, TX 75380		

NOTIFICATION DATE	DELIVERY MODE
04/21/2008	ELECTRONIC

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PTOL-90A (Rev. 04/07)

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Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/660,013
Filing Date: September 11, 2003
Appellant(s): KIRKLAND ET AL.

Gerald H. Glanzman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/14/2008 appealing from the Office action mailed 08/10/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Patent No.: US 7,136,932 B1 issued to Schneider.

NEW GROUND(S) OF REJECTION

Claims 8-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,136,932 B1   SCHNEIDER   11-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-13 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per independent claim 8

· The independent claim 8 is directed to a "data processing system" which has the claimed steps are being performed by software, not by a computer hardware component. It fails to fall with one of four statutory categories of invention, process, machine, manufacture and composition. Thus it is software per se.

Moreover, in the instant specification, describes "data processing system" as a form of a computer-readable storage medium, which is a type of signal bearing media:

"It is important to note that while the present invention has been described in the context of a fully functioning data processing system, those of ordinary skill in the art will appreciate that the processes of the present invention are capable of being distributed in the form of a computer readable medium of instructions and a variety of forms and that the present invention applies equally regardless of the particular type of signal bearing media actually used to carry out the distribution. " (see page 18, lines 14-23).

The dependent claims (9-13) are rejected under the same rational.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Patent

No.: US 7,136,932 B1 issued to Schneider.

With respect to claim 1, Schneider teaches a method in a data processing

system for searching for Web pages within a Web site (a system for searching web

pages from one of search engines to locate web pages or hits within a Web site from

clients (item 110): see fig. 1a and 1b, and col. 17, lines 34-44; also col. 10, lines 58-67),

the method comprising:

receiving a search statement as a result of a user input, wherein the search

statement includes a universal resource identifier and a regular expression (receiving

the input search request or search or query string including URI or string of characters

for identifying an abstract or physical resource from the client of the system: see fig. 2a,

col. 4, lines 30-56 and col. 18, lines 30-56);

retrieving universal resource identifiers associated with the universal resource

identifier in the request to form retrieved universal resource identifiers (retrieving from a

database to generate valid URIs based on the search string: fig. 16 and col. 34, lines

18-32);

parsing the retrieved universal resource identifiers for the regular expression to

form search results (parsing retrieved URIs via a parsing schema: see fig. 2b, item 260

and 2a, item 210: col. 21, lines 48-63; also col. 30, lines 30-42 and col. 18, lines 30-55);

and

returning the search results, wherein the search results include a list of universal

resource identifiers associated with the Web pages within the Web site (the result of the

search is displayed (item 222 in fig. 2a) and as a list of valid URIs (fig. 13): col. 30, lines

22-30 and col. 18, lines 40-55).

With respect to claim 2, Schneider teaches wherein the search results are

returned as a Web page, wherein the universal resource identifiers are presented as a

set of links, wherein selection of a link within the set of links causes a Web page

identified by the link to be retrieved (the result is a list of URI or a set of web pages,

which is also a hyperlinks: fig. 13, col. 30, lines 22-30; also see col. 17, lines 35-45 and

col. 18, lines 5-12).

With respect to claim 3, Schneider teaches wherein the regular expression is

separated from the universal resource identifier by a delimiter (delimiters in the search

string: fig. 18, col. 39-55; col. 19, lines 45-65 and col. 35, lines 58-67).

With respect to claim 4, Schneider teaches wherein the universal resource identifier is a domain name (paring the search string including domain name: col. 18, lines 40-67 and col. 19, lines 1-20).

With respect to claim 5, Schneider teaches wherein the parsing step includes: searching a table of contents for a match to the regular expression, wherein the table of contents contains the retrieved universal resource identifiers (a table of generated URIs: fig. 13).

With respect to claim 6, Schneider teaches wherein retrieving, parsing, and returning steps are performed by a server hosting a Web site identified by the universal identifier, a proxy server, or a client at which the user input was entered (parsing and returning the result from a web server and proxy server: col. 22, lines 8-67 and col. 25, lines 27-52).

Claim 7 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 8 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 9 is essentially the same as claim 2 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 10 is essentially the same as claim 3 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 11 is essentially the same as claim 4 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 12 is essentially the same as claim 5 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 5 hereinabove.

Claim 13 is essentially the same as claim 6 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 6 hereinabove.

Claim 14 is essentially the same as claim 1 except that it is directed to a computer program product rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

With respect to claim 15, Schneider teaches a method in a data processing system for searching for Web pages within a Web site (a system for searching web pages from one of search engines to locate web pages or hits within a Web site from clients (item 110), client side browsers, such as Netscape Navigator or Microsoft Internet Explorer with GUI: see fig. 1a and 1b, and col. 17, lines 34-44; also col. 10, lines 58-67; also col. 3, lines 60-65), the method comprising:

receiving a search statement from a user at a client browser, wherein the search

statement includes a universal resource identifier and a regular expression (receiving

the input search request or search or query string including URI or string of characters

for identifying an abstract or physical resource from the client of the system: see fig. 2a,

col. 4, lines 30-56 and col. 18, lines 30-56; also, figs. 2a and 2b, col. 18, lines 35-45 and

fig. 210 in 2b; also, col. 4, lines 30-56 and col. 32, lines 45-55). The search string may

be a string such as http://example.com to get the URI "http://www.example.com (col. 10,

lines 5-10);

in response to receiving the search statement at the client browser, sending a

request, by the client browser, to a server to retrieve a table of contents, wherein the

table of contents comprises universal resource identifiers associated with the universal

resource identifier in the request (figs. 2s, 4s and 13: the input from client's web browser

having GUI to receiving the input request or input string or search string as an

expression including URI to against the database server and the output is a search

result with a table of list of retrieved URIs that match the entered search string: col. 19,

lines 65-67, col. 20, lines 1-32, and col. 30,, lines 22-28);

receiving the table contents from the server (the search result of the search as

shown in the fig. 13 with generated URI: col. 30, lines 22-28);

parsing the universal resource identifiers in the received table of contents for the

regular expression, by the client browser, to form search results (figs. 2s', 7-9, and col.

30, lines 38-45; parsing retrieved URIs via a parsing schema: see fig. 2b, item 260 and

2a, item 210: col. 21, lines 48-63; also col. 30, lines 30-42 and col. 18, lines 30-55); and

displaying the search results to the user, wherein the search results include a list

of universal resource identifiers associated with the Web pages within the Web site (the

result of the search is displayed (item 222 in fig. 2a) and as a list of valid URIs (fig. 13):

col. 30, lines 22-30, col. 4, lines 10-15, col. 18, lines 40-50 and fig. 5, col. 24, lines 45-

65).

(10) Response to Argument

Argument:

Appellant argues that "Schneider fails to teach the feature of receiving a search

statement as a result of a user input, wherein the search statement includes a universal

resource identifier and a regular expression." (page 12, lines 24-26, page 13, the last

paragraph and page 14, the first paragraph, in the Appeal brief).

Response:

In response to Appellants' arguments, Examiner respectfully disagrees as

Schneider teaches a user input search string or search request, an address

corresponding to a prefix or suffix delimiter, or component data for the purpose of

generating a resolvable URI from a TLDA to be received as shown in fig. 2a, item 210.

The search string includes at least URI and/or URL including expression such as

domain name, path and search term. As we known that a Uniform Resource Identifier

(URI) is a compact string of characters used to identify a name a resource. URIs are

defined in schemas defining a specific syntax and associated protocols. While URL is a

URI that, in addition to identifying a resource, provides means of acting upon or

obtaining a representation of resource by describing its primary access mechanism or

network "location". For example the search string including URI and expression such as

http://www.example.com:80/index.html#appendix: which is a URI and regular

expression: (www.example.com) example's home page and expression:

(80/index.html#appendix), where "80" is the port connection for the http; "index.html" is

a file name on the server, and "index.html" having "appendix", which is the identifier to

display a specific portion of the HTML file called "index". Also, another search string or

request, for example, such as http://msie.yahoo.com/autosearch?% s. This is includes

URI and regular expression: yahoo home page, path name or file name is autosearch

and the "%" is filled in with information regarding the search terms (col. 4, lines 30-56,

col. 9, lines 38-67, col. 10, lines 58-67 and col. 11, lines 45-67; also, see col. 18, lines

30-56 and col. 22, lines 8-67).

Argument:

Appellant argues that "Schneider fails to teach the feature of parsing the

retrieved universal resource identifiers for the regular expression to form search

results." (page 14, the second paragraph, page 16, the 5th paragraphs, in the Appeal

brief).

Response:

In response to Appellants' arguments, Examiner respectfully disagrees as

Schneider teaches generating a valid URI from the input search string or request and

retrieved TLD: In a hierarchical naming system such as the DNS, a first domain may

represent the highest level domain (HLD). A HLD that is determined not resolvable is

referred to as a Top Level Domain Alias (TLDA) whereas a resolvable HLD is referred

to as a Top Level Domain (TLD). Any domain name that is valid and not registered as

part of the DNS, or that is not valid (e.g., SLD/3LD, etc. is greater than 63 characters,

and/or characters other than that of A to Z, a to z, 0 to 9, and hyphen, and/or domain

names represented in other character sets) or any domain name having a TLDA is

called a fictitious domain name (FDN). For the purposes of illustration the use of

TLDs, further includes a plurality of domains that do not represent a hostname.

For example, to generate a new URL, using the fig. 2b for parsing an URI or URL such

as http://united.states with scheme IFQDNIPortIPath: where http is the scheme, domain

name or host name is united.states, there is no Port or Path on that search string.

Another example with http://www.example.com:80/index.html#appendix; domain name

is example, port is 80 and path is index.html#appendix. (col. 21, lines 35-67 and fig. 2b).

The search string includes URI or URL and expression and it is parsed as shown in fig.

2b in order to get search result as shown in the fig 3 in the step 218 in fig. 2a).

Argument:

Appellant argues that "parsed components are only occurs when input received

does not contain a valid URI." (page 15, lines 5-7).

Response:

In response to Appellants' arguments, Examiner respectfully disagrees as

Schneider teaches parsing the input string URI or retrieved URI as recited in the claim

The retrieved URI is always a valid or no valid URL. Because they are retrieved from

registry and matched record of registered name (see fig. 14a and fig. 16). Noted that

recited claim does not including parsing the valid or invalid URI.

Argument:

Appellant argues that "The URLs contained in fig. 13 are not retrieved universal

identifier as recited in claim 5 and 12." (page 17, the third paragraph, in the Appeal

brief).

Response:

In response to Appellants' arguments, Examiner respectfully disagrees as

Schneider teaches as shown in fig. 13, generated URI or retrieved URI. During the

process of generating URL, the resolvable TLD is retrieved from a matching registration

record and name in the registry and then URI is calculated and generated as shown in

figs. 4a and 14a (col. 30, lines 35-45 and also, col. 20, lines 40-60).

Argument:

Appellant argues that "Schneider fails to teach the feature of in response to

receiving the search statement at the client browser, sending a request, by the client

browser, to a server to retrieve a table of contents, wherein the table contents

comprises universal resource identifiers associated with the universal resource identifier

in the request." (page 18, the last paragraph, in the Appeal brief).

Response:

In response to Appellants' arguments, Examiner respectfully disagrees as

Schneider teaches as shown in fig. 1a, Network, Internet, and client, who is sending a

request from his/her computer to server via Internet network to retrieve web page or

content of information (col. 17, lines 32-67 and col. 18, lines 1-12). Also, teaches a

method for sending a message with a first email address having a first domain name

includes determining that the first domain name is a fictitious domain name

with respect to a domain name system root, generating a second email address

having a second domain name that is not fictitious, and sending the message

with the second email address. Resolvers query the DNS by directing queries at name

servers, which contain parts of the distributed database that is accessed by using the

DNS protocols to translate domain names into IP addresses needed for transmission of

information across the network. The Web dispenses with command-line utilities, which

typically require a user to transmit sets of commands to communicate with Internet

server (figs. 2s, 4s and 13: the input from client's web browser having GUI to receiving

the input request or input string or search string as an expression including URI to

against the database server and the output is a search result with a table of list of

retrieved URIs that match the entered search string: col. 19, lines 65-67, col. 20, lines 1-

32, and col. 30,, lines 22-28).

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal as to the claims subject to the new ground of rejection:**

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO

MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to

reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex

parte reexamination proceedings.

Respectfully submitted, ·

Anh LY, /AL/
Examiner 2162

A Technology Center Director or designee must personally approve the

new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

John E. Breene (SPE TC2100)

/John Breene/

Supervisory Patent Examiner, Art Unit 2162

Ali Mohammad (SPE TC2100)

/Mohammad Ali/

Supervisory Patent Examiner, Art Unit 2169
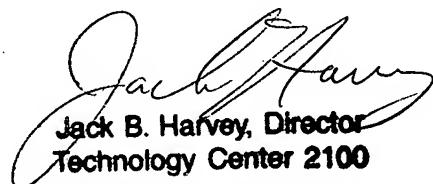
Jack B. Harvey, Director
Technology Center 2100

APRIL 1st, 2008

Gerald H. Glanzman
YEE & ASSOCIATES, P.C.
P.O. BOX 802333
Dallas, TX 75380